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Supreme Court, U.S.
FILED
DEC 20 2000
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No. 00-689

In The

Supreme Court of the United States

MICHAEL BOLTON, individually and d/b/a MR. BOLTON'S MUSIC, INC., ANDREW GOLDMARK, NONPAREIL MUSIC, INC., WARNER CHAPPELL MUSIC LIMITED, WARNER-TAMERLANE PUBLISHING CORP., WB MUSIC CORP. and SONY MUSIC ENTERTAINMENT, INC.,

Petitioners,

v.

THREE BOYS MUSIC CORPORATION,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Ninth Circuit

BRIEF BY AMICUS CURIAE RECORDING INDUSTRY ASSOCIATION OF AMERICA, INC. IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI

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I. INTRODUCTION

The Recording Industry Association of America, Inc. (RIAA) ("amicus")[1] supports the petition for a writ of certiorari to review the May 9, 2000 decision (reproduced in Appendix A) of the Ninth Circuit Court of Appeals, reported at 212 F. 3d 477.[2]

This case raises important questions concerning the proper role of courts in setting benchmarks for what constitutes substantial evidence of "access" and the need for independent review of jury verdicts that find protected speech to constitute copyright infringement. The Ninth Circuit's decision conflicts with decisions of this Court and other circuits and ignores the duty of appellate courts to conduct de novo or independent review of legal and policy issues, especially where liability depends upon setting and determining the boundaries of free speech.

It is not surprising that commercially successful songs, recordings, movies, books and television series attract copyright infringement claims. The substantial remedies provided by the Copyright Act[3] – damages, disgorgement of profits, injunctive relief, destruction and attorney's fees – offer plaintiffs a powerful incentive to

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[1] As required by Sup. Ct. R. 37.6, RIAA represents that none other than the amicus has made a monetary contribution to the preparation or submission of this brief.

[2] All parties have given their written consents to the filing of this Brief, which consents will be filed with the Court.

[3] Copyright Act of 1976, as amended, §§ 502-505, 17 U.S.C. §§ 502-505.

sue. Nor should it be surprising that the threat of protracted litigation and the risk of large jury verdicts can serve to chill investment of creative efforts and money.[4]

But songs, motion pictures, television programs and books are "speech" entitled to First Amendment protections. *See Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 578 (1977) ("there is no doubt that entertainment, as well as news, enjoys First Amendment protection"); *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952) (books, newspapers, magazines and movies are forms of expression that do not lose their First Amendment protections because they are sold for profit); *Texas v. Johnson*, 491 U.S. 397, 406 (1989) (to be protected under Free Speech Clause, activity must be sufficiently imbued with elements of communication). In areas other than copyright, such as defamation law, where tort law liability rules put speech at risk, courts have fashioned special substantive and procedural rules: burdens of proof are shifted, substantive rules are changed to expand the risk-free sphere of speech, summary adjudication is encouraged, and verdicts are subjected to independent review on appeal. *See Bose Corp. v. Consumers Union*, 466 U.S. 485, 502-511 (1984); E. Volokh & B. McDonnell, "Freedom of Speech and Independent Judgment Review

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[4] In this case, the jury awarded plaintiff many times more than the amounts earned by the defendant creators, Bolton and Goldmark. Petition for certiorari, at 10. In addition, because of contractual and implied indemnities, creators may be called on to defend and indemnify distributors and retailers for amounts much larger than they ever realized from creating the allegedly infringing work.

in Copyright Cases," 107 Yale L.J. 2431, 2439-41 (1998) ("Volokh" hereafter).

Although this Court has agreed that the copyright law's idea/expression dichotomy "strike[s] a definitional balance between the First Amendment and the Copyright Act",[5] courts have been slow to develop and apply special procedural and substantive rules to protect the free speech interests that conflict with copyright law.[6] The Ninth Circuit's decision threatens to undo what case law protections have developed.

Over fifty years ago, the then-leading decision, *Arnstein v. Porter*, 154 F. 2d 464, 468 (2d Cir. 1946), announced a rule openly hostile to summary judgment, or any disposition as a matter of law, requiring a trial if there was even the "slightest doubt" about the circumstantial evidence of copying, and disparaging a judge's ability or duty to decide substantial similarity issues, as a matter of law. 154 F. 2d at 468, 473.

Over the next 50 years, even as this Court reversed the early hostility to summary judgments, the circuits repudiated the "slightest doubt" rule of *Arnstein* and came to agree that meritless infringement claims could be dismissed as a matter of law where plaintiff failed to show (1) that the subject works were substantially the same in their protectible expression, or (2) that any actionable similarities arose from actual copying, based

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[5] *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 556 (1985), quoting the Second Circuit's opinion, 723 F. 2d 195, 203 (2d Cir. 1983).

[6] *See Volokh*, 107 *Yale L.J.* at 2439-41.

on circumstantial evidence that such similarities indicated copying ("probative similarity") and that the creator of defendant's work had a reasonable opportunity to read or hear plaintiff's work ("access") by reason of wide public dissemination or through intermediaries.

The Ninth Circuit's decision below threatens to undermine those salutary and nationwide rules. Although the Ninth Circuit purports to render a narrow, fact-specific decision ("we will not disturb the jury's factual and credibility determinations"), App. A, at 8, by relying on the "slightest doubt" rule of *Arnstein* in copyright litigation, and applying that abandoned rule where evidence of "access" was *de minimis*, it exposes authors' reputations and incomes to unreviewable decisions by juries allowed to speculate about evidence or the lack of it.

Indeed, the Ninth Circuit's apparent encouragement of standard-free decision-making is inexplicable in light of the well-established rule that copyright rules regulating speech pass constitutional muster only because they are intended to balance First Amendment considerations. *See, Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 555-60 (1985); *Sid & Marty Krofft Television Prods., Inc. v. McDonalds Corp.*, 562 F. 2d 1157, 1170 (9th Cir. 1977); Volokh, 107 Yale L.J. at 2439-41; 1 *Nimmer*, § 1.10, at 1-66.43 to 1-82.

The stakes in assuring the courts' role as gatekeepers in copyright cases are high. For example, music is increasingly a matter not only of art, but of commerce. Sound recordings comprise an almost $15 billion domestic industry, and the foreign sales of U.S. recorded music

amount to more than $12 billion, representing approximately sixty percent of the world's consumption of music.

The composers, authors and other creative artists whose works form the backbone for these burgeoning segments of the economy should not be made to labor under the chilling effect of meritless litigation encouraged by a lax standard of "access" that allows juries to assume the creators of new works have unlawfully and subconsciously "copied" materials, which they never heard or saw. Nor should an author be subjected to the risk of liability in a case involving non-literal similarities between works – because courts are forced to defer to a jury's drawing of the constitutional balance between the First Amendment and the Copyright Act.

The ramifications of the Ninth Circuit's decision are substantial, national in scope, and chilling to the speech interests of creative artists and their distributors. In particular, by ignoring decades of precedent,[7] the Ninth Circuit resurrects discredited copyright analyses and effectively abrogates the "gatekeeping" function of the courts in copyright cases. By deferring to the jury's unbounded speculation about "access," and seemingly reopening the door to a bygone time in which dispositions as a matter of law met with extreme disfavor, the decision will prevent district courts from ruling as a

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[7] *See generally* 4 M. & D. Nimmer, *Nimmer On Copyright*, §§ 13.04[E][3] at 13-89 to -100 (2000) ("*Nimmer*").

matter of law that meritless claims rest on mere conjecture. Forum-shopping will be encouraged.[8] The Ninth Circuit thus directly contradicts this Court's admonition that "it is peculiarly important that the boundaries of copyright law be demarcated as clearly as possible." *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 526 (1994).

II. INTEREST OF THE AMICUS

RIAA is a not-for-profit corporation, whose membership consists of sound-recording producers and phonorecord manufacturers.[9] RIAA's members create, manufacture or distribute more than 90% of the authorized sound recordings in the United States, including compact disks, cassette tapes and long-playing records. Sound recordings comprise an almost $15 billion domestic industry, and foreign sales of U.S. recorded music amount to more than $12 billion, representing approximately sixty percent of the world's consumption of music. RIAA's purposes include overseeing copyright

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[8] Although the conflict in the circuits created by the Ninth Circuit's decision itself merits review, this Court has granted review on important copyright issues even in the absence of such conflicts. *E.g.*, *New York Times Co. v. Tasini*, Dkt. No. 00-201, *cert. granted* 11/6/2000 (where recent circuit decision threatens to disrupt settled publishing practices); *Mills Music v. Snyder*, 469 U.S. 153 (1984) (holding that publisher was entitled to share in royalties from derivative works under terms of grant from author; petitioner alleged no conflict in the circuits).

[9] The RIAA has over 300 members, including such companies as EMI Recorded Music North America, BMG Entertainment North America, Universal Music Group, Warner Music Group and Sony Music Entertainment Inc. (a petitioner in this proceeding).

infringement litigation for member companies, combating all forms of music piracy throughout the United States, and ensuring that copyright legislation maintains the appropriate balance for fostering creativity in music through increased investment, production and distribution.

III. REASONS WHY THE PETITION SHOULD BE GRANTED

Over fifty years ago, the case law authority for prompt dismissal of meritless copyright claims was at its nadir. In *Arnstein v. Porter*, 154 F. 2d 464, 468 (2d Cir. 1946), the Second Circuit announced a rule openly hostile to the new summary judgment procedures of the recently enacted Federal Rules of Civil Procedure. It reversed a summary judgment in favor of the famous composer, Cole Porter, that had held that plaintiff failed to show either that the works were substantially the same or that any similarities arose from copying by defendant. The Second Circuit concluded there must be a trial, and deference to a jury verdict, if there were even the "slightest doubt" about the circumstantial evidence of copying, based on plaintiff's fanciful theory that Porter "could have" obtained access to plaintiff's song by having "stooges" burglarize plaintiff's apartment. The *Arnstein* court also disparaged a judge's ability or duty to decide substantial similarity issues, stating that perhaps if competing works were "When Irish Eyes Are Smiling" and Ravel's "Bolero", then a court could dismiss as a matter of law. 154 F. 2d at 468, 473.

Over the next 50 years, the Second and other circuits, led by decisions of this Court[10] undermined, discredited and abandoned the "slightest doubt" rule of *Arnstein*. The circuits came to agree that meritless claims could be dismissed where a plaintiff failed to show (1) that the works were substantially the same in their protectible expression,[11] or (2) that any actionable similarities arose from actual copying, based on evidence that such similarities indicated copying ("probative similarity")[12] and that the creator of defendant's work had a reasonable opportunity to read or hear plaintiff's work ("access") by reason of wide public dissemination[13] or through intermediaries.[14]

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[10] *E.g., Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251-52 (1986) (courts are to consider the constitutionally mandated "clear and convincing" standard of proof regarding alleged defamation of public figures); *First National Bank of Arizona v. Cities Service Co.*, 391 U.S. 253 (1968); *see Ferguson v. National Broadcasting Co.*, 584 F. 2d 111, 114 (5th Cir. 1978).

[11] 3 *Nimmer*, § 12.10[B][3], at 12-151 to -156; 4 *Nimmer*, § 13.01[B] at 13.8 to -14.

[12] 4 *Nimmer*, § 13.01[B], at 13.10 to -13.

[13] *See, e.g., Ferguson v. National Broadcasting Co.*, 584 F. 2d 111, 112-13 (5th Cir. 1978); *Selle v. Gibb*, 741 F. 2d 896, 901 (7th Cir. 1984); *Takeall v. Pepsico, Inc.*, 809 F. Supp. 19, 21 (D. Md. 1992), *aff'd*, 14 F. 3d 596 (4th Cir. 1993), *cert. denied*, 512 U.S. 1236 (1994); *Benson v. Coca-Cola Co.*, 795 F. 2d 973, 975 (11th Cir. 1986); *Repp v. Webber*, 858 F. Supp. 1292, 1301-03 (S.D.N.Y. 1994), *reversed on other grounds*, 132 F. 3d 882 (2d Cir. 1997), *cert. denied*, 525 U.S. 815 (1998).

[14] *See, e.g., Grubb v. KMS Patriots, L.P.*, 88 F. 3d 1, 3-5 (1st Cir. 1996); *Towler v. Sayles*, 76 F. 3d 579, 582-83 (4th Cir. 1996); *Jason v. Fonda*, 698 F. 2d 966, 967 (9th Cir. 1982); *Meta-Film Assocs., Inc. v. MCA, Inc.*, 586 F. Supp. 1346, 1355-59 (C.D. Cal. 1984); *Herzog v. Castle Rock Entertainment*, 193 F. 3d 1241 (11th Cir. 1999).

The Ninth Circuit's decision below threatens to undermine those salutary and nationwide rules. By resurrecting the "slightest doubt" rule of *Arnstein* in copyright litigation, the Ninth Circuit's decision exposes authors' reputations and incomes to unreviewable decisions by juries based on speculation and conjecture.

A. THE NINTH CIRCUIT HAS SO LOWERED THE STANDARD TO PROVE "ACCESS" AS TO THREATEN ALL FUTURE ATTEMPTS TO DISPOSE OF UNMERITORIOUS CLAIMS AS A MATTER OF LAW

The Ninth Circuit purports simply to affirm a jury's resolution of credibility issues, and thus "not [to] establish[ ] a new standard for access in copyright cases." App. A, at 8. However, the issue before the Ninth Circuit was not about disputed evidence or credibility,[15] but whether the acknowledged "evidence" was substantial enough to support a finding of "access" *or* whether the proffered evidence of access constituted only impermissible speculation and conjecture. *See Jason v. Fonda*, 698 F. 2d 966, 967 (9th Cir. 1982) (a "bare possibility" is not sufficient evidence). The Ninth Circuit's conclusion that "access" was "entirely plausible" from the evidence in the record (App. A, at 5061), creates a radically new and lax "access" standard that is completely at odds with that circuit's no-

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[15] A trier's disbelief of a defendant's denial of access does not constitute affirmative substantial evidence of access. *See Bose Corp. v. Consumers Union*, 466 U.S. 485, 512 (1984); *Goldhirsh Group, Inc. v. Alpert*, 107 F. 3d 105, 109 (2d Cir. 1997); *Newton v. National Broadcasting Co.*, 930 F. 2d 622, 680 (9th Cir. 1990), *cert. denied*, 502 U.S. 866 (1991).

circuit's no-bare-possibility standard in *Jason* and all other circuits which have opined on "access" since *Arnstein*. The Ninth Circuit exaggerated this misstep by relying on the long-discredited "slightest doubt" rule of *Arnstein*, 154 F. 2d at 468. *See* Petition, at 11. If the Ninth Circuit's decision[16] stands, district courts will consider themselves effectively disabled from ruling as a matter of law that *any* evidence offered as proof of access is mere conjecture, and insufficient.

The issue on appeal – the sufficiency of the evidence presented by plaintiff as a matter of law to support the "access" finding of the jury – did not present a factual or "credibility" issue but rather a legal issue, which may be disposed of under the same standard applicable to a motion for summary judgment. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 251-52 (1986). Ultimately, the question of whether the evidence in this case was sufficient presented a policy issue for judges, suitable for determination as a matter of law. Thus, the Ninth Circuit's decision will almost certainly be trumpeted as the standard for what access evidence is sufficient to create a triable issue in the context of motions for summary judgment and

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[16] The Ninth Circuit further confounded the "access" analysis by relying on decisions about "subconscious copying," *in which the defendants' "access" to the plaintiff's work had first been admitted or decided* and the only remaining issue was whether the defendants could be held culpable for *unintentionally* copying the plaintiffs' works. App. A, at 5-8. By purporting to determine the existence of "access" by reference to the unrelated theory of "subconscious copying," the Ninth Circuit effectively "decided" that substantial evidence of access existed by *assuming* its existence.

judgment as a matter of law, and on appeals from bench trials as well as jury verdicts. For, although it is difficult to create a bright line test on this issue, courts must create benchmarks on a case by case basis that guide authors, their attorneys, and potential plaintiffs. *See* Volokh, 107 Yale L.J. at 2455-59. The Ninth Circuit's decision threatens to undermine all the benchmarks created these past fifty years.

As a result, the Ninth Circuit's lowered threshold for access directly conflicts with its own authority in *Jason*,[17] and with the law of other circuits concerning access allegedly attained through public dissemination. *See, e.g., Ferguson v. National Broadcasting Co.*, 584 F. 2d 111, 112-13 (5th Cir. 1978); *Selle v. Gibb*, 741 F. 2d 896, 901 (7th Cir. 1984); *Takeall v. Pepsico*, 809 F. Supp. 19, 21 (D. Md. 1992), *aff'd*, 14 F. 3d 596 (4th Cir. 1993); *Benson v. Coca-Cola Co.*, 795 F. 2d 973, 975 (11th Cir. 1986); *Repp v. Webber*, 858 F. Supp. 1292, 1301-03 (S.D.N.Y. 1994), *reversed on other grounds*, 132 F. 3d 882 (2d Cir. 1997).[18]

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[17] Because the Ninth Circuit creates a rule of total deference to a jury determination of "access", it does not attempt to distinguish *Jason* (App. A, at 5) which was decided on a motion for summary judgment. It fails to acknowledge that *Jason* created a benchmark that "access" evidence as speculative as that presented to the jury in this case was not substantial evidence.

[18] By a parity of reasoning, the Ninth Circuit's highly deferential standard will no doubt be argued to apply to claims of access through intermediaries, putting the Ninth Circuit in direct conflict with decisions granting summary judgment, or judgment as a matter of law, for defendants under that fact pattern. *See, e.g., Grubb v. KMS Patriots, L.P.*, 88 F. 3d 1, 3-5 (1st Cir. 1996); *Towler v. Sayles*, 76 F. 3d 579, 582-83 (4th Cir. 1996);

Inferential proof of copying-in-fact through evidence of access and probative similarity is a "question of probabilities." 2 P. Goldstein, *Copyright*, § 7.2.1, at 7:6 (2d ed. 2000). The "probability" of copying may be high where the evidence of access is strong. However, if composers, writers and other creative artists may be deemed to have "access" to works that received minimal public dissemination decades earlier, in geographically remote areas, it is certain that "copying" will be inferred in many cases where defendants never heard or saw plaintiff's work. When lax standards are allowed to prove "access", they improperly punish creative artists by allowing juries – without clear standards – to infer copying based on extraneous factors or hunches.

Under these standards, or the lack of them, composers, writers and other creative artists will be put to a tremendous disadvantage in defending an ever-increasing number of infringement actions brought by the owners of barely disseminated works.[19]

Meta-Film Assocs., Inc. v. MCA, Inc., 586 F. Supp. 1346, 1355-59 (C.D. Cal. 1984); *Herzog v. Castle Rock Entertainment*, 193 F. 3d 1241 (11th Cir. 1999). And, *see Ellis v. Diffie*, 177 F. 3d 503 (6th Cir. 1999) (no "clear error" in rejecting speculative evidence of access through intermediary record executive).

[19] As a practical matter, the Ninth Circuit's lowered standard will charge creators of new works with notice of huge numbers of prior works with extremely limited dissemination. In effect, the Ninth Circuit approved a jury verdict consistent with the conclusion that the petitioner-composers probably heard and recalled *all* barely disseminated music for at least the past 25 years. During the Copyright Office's fiscal year ended June 30, 1967 *alone* (which includes the period during which respondent's song was supposedly "disseminated"), copyrights

Instead of a level playing field, defendants in such cases will find that because of limited public dissemination of plaintiff's work, to which they were never exposed, they can be inferentially held to have "copied." And, because a defendant's creative work frequently is composed in private, defendants will not easily be able to refute the unfounded inference with proof of independent creation. In practice, the mere fact that a defendant's work is somewhat similar to an earlier, obscure work will become the standard for liability. Creators will be pressed to prove "novelty" to avoid liability.

The Ninth Circuit's lowering of the bar for proof of "access" will also have another unintended consequence. The same loosened "access" standard that facilitates proof of infringement may also be used by defendants to create an inference that material in a *plaintiff's* copyrighted work was copied from a prior work and thus is not "original" and entitled to protection. 1 *Nimmer*, § 2.01; 3 *Nimmer*, § 12.11[B][1] at 12-164 & n. 48. As a practical matter, copyright owners may be required to prove that their works are "novel," unlike any prior work. *See* 1 *Nimmer*, § 2.01[A] at 2-8 to -9 ("such a course of action would constitute the most radical upheaval in all of copyright doctrine"). Thus, creators will be subjected to attack from both directions.

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in 79,291 musical compositions were registered in the U.S. *Annual Report of the Register of Copyrights* at 26 (1968). It would be just as illogical to assume that every member of the Ninth Circuit was familiar with the "expression" of every appellate brief filed in that or in any other circuit court during the past 25 years. *Cf. Meta-Film*, 586 F. Supp. at 1355-56.

B. THE NINTH CIRCUIT'S RELIANCE ON THE DISCREDITED *"ARNSTEIN"* DECISION THREATENS TO DE-STABILIZE PRECEDENTS ALLOWING COURTS TO RULE AS A MATTER OF LAW WHETHER COMPETING WORKS ARE SUBSTANTIALLY SIMILAR IN THEIR PROTECTIBLE EXPRESSION

Liability for infringement requires proof that original, protected expression owned by a plaintiff has been copied from plaintiff's work by defendant. *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 361 (1991). It is now well-established that "copying" involves two distinct elements: a showing (1) that defendant's work is substantially similar to protected expression in plaintiff's work ("substantial similarity"); and (2) that such substantial similarities were in fact derived from plaintiff's work (copying-in-fact), and not by copying from other sources (*e.g.*, public domain or licensed works) or independent creation. *Feist*, 499 U.S. at 361 ("Not all copying . . . is copyright infringement"); 4 *Nimmer*, § 13.01[B] at 13-8 to -14; *see also*, Volokh, 107 Yale L.J. at 2439 & n. 55.

The 1946 *Arnstein* decision was hostile to the idea that a court could determine as a matter of law the issue of whether two works were substantially similar in their protected expression. *Arnstein*, 146 F. 2d at 473 (stating the issue to be entirely *factual*, and allowing that summary judgment might be proper if the competing works were "When Irish Eyes Are Smiling" and Ravel's "Bolero"). Decades of subsequent precedent have shown the basic assumption of *Arnstein* to be flawed.

The "substantial similarity of expression" issue is often a *legal* issue, or at least a mixed issue of fact or law, susceptible of resolution as a matter of law. Volokh, 107 Yale L.J. at 2439-40 & n. 57. This is because one component of the issue – protectibility – is often purely legal: plaintiff's monopoly does not include ideas, facts, scenes à faire or the commonplace.[20] *See Feist*, 499 U.S. at 361; *Williams v. Crichton*, 84 F. 3d 581, 587 (2d Cir. 1996); *Walker v. Time-Life Films, Inc.*, 784 F. 2d 44, 48 (2d Cir.), *cert. denied*, 476 U.S. 1159 (1986); *Hoehling v. Universal City Studios, Inc.*, 618 F. 2d 972, 977-80 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980) (distinguishing *Arnstein*), *cert. denied*, 449 U.S. 841 (1980); *Towler*, 76 F. 3d at 583-84 (4th Cir. 1996); *Kouf v. Walt Disney Pictures & Television*, 16 F. 3d 1042, 1044-46 (9th Cir. 1994); *Berkic v. Crichton*, 761 F. 2d 1289, 1293-94 (9th Cir.), *cert. denied*, 474 U.S. 826 (1985); *Litchfield v. Spielberg*, 736 F. 2d 1352, 1356-57 (9th Cir. 1984), *cert. denied*, 470 U.S. 1052 (1985); *Olson v. National Broadcasting Co.*, 855 F. 2d 1446, 1451-53 (9th Cir. 1988) (JNOV); *Nash v. CBS, Inc.*, 899 F. 2d 1537, 1539, 1543 (7th Cir. 1990); *Herzog*, 193 F. 3d 1241 (11th Cir. 1999). Moreover, when the alleged similarities are non-literal, a policy issue exists about the extent to which a court will expand plaintiff's monopoly beyond the literal to prohibit defendant's non-literal resemblance, *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F. 2d 197, 201 (9th Cir. 1989); 1 *Nimmer*, § 1.10[B][2] at 1-75 to -76; 4 *Nimmer*,

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[20] The first step in analyzing "substantial similarity" is to determine the scope of protection for plaintiff's and defendant's works. *Feist*, 499 U.S. at 361-62; *Apple Computer, Inc. v. Microsoft Corp.*, 35 F. 3d 1435, 1442-43 (9th Cir. 1994), *cert. denied*, 513 U.S. 1184 (1995).

§ 13.03[A][1] at 13-29 to -36[21] – an issue this Court has yet to decide. *Harper & Row*, 471 U.S. at 547.

This Court has agreed that the copyright law's idea/expression dichotomy has a constitutional dimension and "strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author's expression." *Harper*, 471 U.S. at 556. "*Harper & Row* thus suggests that the line between using others' expression and using their ideas is of First Amendment significance." Volokh, 107 Yale L.J. at 2434.

This Court noted the constitutional infirmity of deferring to triers of fact on issues fraught with constitutional significance, in the trade disparagement context:

> Providing triers of fact with a general description of the type of communication whose content is unworthy of protection has not, in and of itself, served sufficiently to narrow the category,

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[21] This policy issue is highlighted because the Ninth Circuit's decision holds that a "combination of unprotectible elements" in a "unique compilation" supports a finding of substantial similarity of protected expression. App. A, at 10. The Ninth Circuit supported its reasoning by citing *Malkin v. Dubinsky*, 146 F. Supp. 111 (S.D.N.Y. 1956), a New York decision that was then required to follow *Arnstein*. App. A, at 9. The circuit did not consider more recent, conflicting decisions in the circuit holding that such "compilation works" are entitled to only "extremely limited copyright protection" (*Harper House*, 889 F. 2d at 205) and that "compilations" of random similarities are not actionable. *Kouf*, 16 F. 3d at 1045-46; *Berkic*, 761 F. 2d at 1293-94; *Litchfield v. Spielberg*, 736 F. 2d 1352, 1356 (9th Cir. 1984). Not only musical works but also biographies, histories and other fact-based works are put at risk by the circuit's decision.

> nor served to eliminate the danger that decisions by triers of fact may inhibit the expression of protected ideas.

Bose, 466 U.S. at 505. For that reason, the *Bose* Court held that courts must independently review judgments that an allegedly disparaging statement is unprotected. 466 U.S. at 511. Since a factfinder in a copyright case may misclassify the defendant's speech as unprotected, or may erroneously conclude that it used another's expression, independent review, not deference, is required. Volokh, 107 Yale L.J. at 2437.

Similarly, since *Arnstein*, the decisions are legion that hold "substantial similarity of protected expression" may be decided as a matter of law. *See Feist*, 499 U.S. at 361; *Williams v. Crichton*, 84 F. 3d 581, 587 (2d Cir. 1996); *Walker v. Time-Life Films, Inc.*, 784 F. 2d 44, 48 (2d Cir.), *cert. denied*, 476 U.S. 1159 (1986); *Hoehling v. Universal City Studios, Inc.*, 618 F. 2d 972, 977-80 (2d Cir. 1980) (distinguishing *Arnstein*); *Towler*, 76 F. 3d at 583-84 (4th Cir. 1996); *Kouf*, 16 F. 3d at 1044-46 (9th Cir. 1994); *Berkic v. Crichton*, 761 F. 2d 1289, 1293-94 (9th Cir. 1985); *Litchfield v. Spielberg*, 736 F. 2d 1352, 1356-57 (9th Cir. 1984); *Olson v. National Broadcasting Co.*, 855 F. 2d 1446, 1451-53 (9th Cir. 1988) (JNOV); *Nash v. CBS, Inc.*, 899 F. 2d 1537, 1539, 1543 (7th Cir. 1990); *Herzog*, 193 F. 3d 1241 (11th Cir. 1999); *see also* 4 *Nimmer*, § 13.03[E][3] at 13-89 to -100 (collecting cases).

By resurrecting *Arnstein*, the Ninth Circuit's decision poses a substantial threat to undermine the "gatekeeping" function of the courts which is recognized in these decisions.

C. THE CIRCUIT'S CREATION OF A UNIQUE AND UNPRINCIPLED "EXCEPTION" TO THE "INVERSE RATIO RULE" IS UNWARRANTED, AND FURTHER EXPOSES AUTHORS TO UNFOUNDED LITIGATION

The Ninth Circuit's decision (App. A, at 10-11), unjustifiably creates a new exception to the "Inverse Ratio Rule" as support for the jury's decision on the "substantial similarity" or improper appropriation issue.[22] In doing so, the circuit illogically, and without any supporting authorities, *sua sponte* converts the "Rule" for the first time into a "one-way street" that deliberately operates only to reduce a plaintiff's burden of proof. This reliance on the Rule and the circuit's newly-minted exception is unwarranted.

The proper context for application of the "Inverse Ratio Rule" is controversial and much debated. *See* 4 *Nimmer*, § 13.03[D] at 13-76 to -78 & n. 198.1. Its proper domain – to weigh the relative probative similarities and access evidence needed to support an inference of *actual copying* – is not presented by this case. What is presented by the Ninth Circuit's decision is the improper expansion of the Rule from the issue of actual copying to that of

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[22] A latent ambiguity has always existed in the Ninth Circuit's statement of the Rule – "a lesser showing of substantial similarity [is required to prove *copying*] if there is a stronger showing of access". App. A, at 10-11. The circuit has rarely been clear whether it uses "copying" to mean actual copying or substantial similarity as to protected expression, or both. Because "Not all copying . . . is copyright infringement", that distinction is critical. *Feist*, 499 U.S. at 361; 4 *Nimmer*, § 13.01[B] at 13-8 to -14; Volokh, 107 Yale L.J. at 2439 n. 55.

substantial similarity of protected expression. See Shaw v. Lindheim, 919 F. 2d 1353, 1362 (9th Cir. 1990). The Ninth Circuit is alone in making this application of the Rule. *See ARC Music Corp. v. Lee*, 296 F. 2d 186, 187-88 (2d Cir. 1961) (rejecting Inverse Ratio Rule in this context). By holding that this Rule even applies to the substantial similarity issue, the Ninth Circuit has further undermined proper independent review of an issue of constitutional dimensions.

Perhaps recognizing the illogic of its application of the Rule in this context, the Ninth Circuit's decision does not attempt to explain *why* less access does not increase the amount of resemblance needed to constitute "substantial similarity of protected expression." Would more access create a broader scope of protected expression? *But see Feist*, 499 U.S. at 361. Would greater access create liability for similarity of *un*protected material? *See id.* The Ninth Circuit reasoned itself into this corner with its earlier decisions; when faced with the reality of its logic, it blinked. The Rule cannot be so applied consistent with this Court's decision in *Feist*.

IV. CONCLUSION

The Ninth Circuit's decision threatens to subject creative efforts, speech interests, and substantial investments to a judicial deference for jury verdicts that improperly sanctions unpredictable legal results, with attendant deleterious consequences both to free speech and the copyright laws. Too much speech will be wrongly punished and too many reputations will be sullied while

the Ninth Circuit's decision percolates through the federal courts, even if the Ninth Circuit ultimately tries to "right" itself. The Petition for a writ of certiorari should be granted.

DATED: December 20, 2000

Respectfully submitted,

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